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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/716,241 | 11/18/2003 | Scott F. Timmons | RESINC-0004-US | 6733 |
| 23770 | 7590 | 04/26/2005 | EXAMINER | |
| PAULA D. MORRIS THE MORRIS LAW FIRM, P.C. 10260 WESTHEIMER, SUITE 360 HOUSTON, TX 77042-3110 | | | MARCANTONI, PAUL D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1755 | |

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,241

Applicant(s)

TIMMONS, SCOTT F.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 15-26, 41, 48, 58, 59, 64, 65, 69, 71, 72, 76, 78-88 and 99-125 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 15-26, 41, 48, 58, 59, 64, 65, 69, 71, 72, 76, 78-88 and 99-125 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's arguments filed 2/15/05 have been fully considered but they are not persuasive.

35 USC 102/103:

Claims 11,15-26,41,48,58,59,64,65,69,71,72,76,78-88 and 99-125 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sobolev et al. '289 B2, Fu et al. '489 or '513, or *Niepelova et al.* (SK 279524).

Note : All references no longer listed in the rejection above were withdrawn.

Art Cited as Relevant Art but not used in Rejection of Claims:

Park (KR '443) and Dolezsai et al. (DE '197) have been cited because they both teach a composition comprising cement such as Portland cement, zeolite, and fly ash.

Suggestions to Amend Claims and/or Specification:

The applicants are respectfully requested to amend both their specification and claims by deleting the terms "Type F, Type C, Type N, etc." and inserting therefor Class F, Class C, Class N, etc. The term Class is the conventional term used to identify the different kinds of fly ash and the term "Type" is not the conventional term for these kinds of fly ash.

The applicants should delete the word "essentially" in the second line of claim 48 so it is then proper Markusch language of --selected from the group consisting of---.

In claim 53, please delete "an amount of". Note that it is evident there needs to be an amount of the substance being added and to state the terms an amount or a first amount, second amount, third amount, fourth amount, a quantity, a second quantity, etc. so these terms are extraneous and should be deleted from the claims.

Delete the term "fourth amount" in claim 69.

Delete the term "various" before the term clays in claim 71,72,76, 84-86, 105-107, and all claims to which it is utilized.

Delete the term "Ordinary" before the term Portland cement in all claims it is used.

Delete "a quantity" in claim 78.

Delete the terms "a first quantity", "a second quantity", a third quantity" in all instances it is used in claim 108 and 115.

Also in claim 108 and 115, delete "a majority of" in the second to last line of the claim.

In claim 123, the terms "the quantity" and "a quantity" should be deleted.

35 USC 112 First and Second Paragraphs (New Matter and Indefiniteness)

Disclaimer: Does not Represent any suggestion in any way to applicant but only a commentary on the state of the claims:

Claims 11,15-26,41,48,58,59,64,65,69,71,72,76,78-88 and 99-125 are rejected both under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the now claimed invention and under the

second paragraph of 35 USC 112 second paragraph as failing to particularly point out and distinctly claim their invention.

The terms “fly ash comprises Type F fly ash” is vague in claim 15 because it is not clear if the fly ash in question is 100% fly ash or is a mixture of more than one type of fly ash. If it is, this claim does not particularly point out and distinctly claim the identity of the other amounts of fly ash. It would appear the specification only supports the addition of one type of fly ash per mixture. The claim would have been more clear had applicants used the fly ash is Class F fly ash. This is not a suggestion but a mere observation on the vagueness of this claim in its present form.

The same goes for claim 18 which would have been more clear had applicants used fly ash is Class C fly ash if they mean that 100% of the fly ash is actually Class C fly ash. Again, this is not a suggestion but an observation of the vagueness of the instant claims.

In claim 78, the newly added limitation “about 80% or more” is new matter not supported by the original disclosure. There is only support for “about 80 wt% pozzolanic material” (see original claim 5 and page 4 lines 1-10 of specification) and about 10 wt% to about 95 wt% pozzolanic material. It seems there is support for a range of about 80 wt% to about 95 wt% (upper limit-see original claim 6). However, applicants “or more” limitation means that their upper limit is new matter because there is no support for any amount higher than about 95 wt% pozzolanic material. Again, this is not a suggestion but merely a comment on the problem of new matter with this claim.

The terms “about 80% or more” is also indefinite. What do applicants mean by or more? They do not particularly point out and distinctly claim the required upper limit of about 95 wt% pozzolanic material required from their original disclosure.

Claim 78 is also indefinite because the amounts do not add up to 100 wt%. Applicants now claim about 80% fly ash, about 10 wt% Portland cement, and zeolite yet they do not claim —about 10 wt% zeolite—which is the remaining amount to equal 100 wt%. Thus it is vague without this amount. It is not enough to simply state a sufficient amount because applicants have already limited themselves to amounts to total 100 wt%.

The terms “one or more alkali containing zeolite catalyst” is new matter in claim 78. There is no support for “one or more” from the original disclosure.

The terms “about 80% by weight one or more type F fly ash” is vague, confusing, and also seems to be new matter because it is not clear if it is inclusive of amounts greater than 80 wt% or only is claiming a single range point of about 80 wt%ⁱⁿ claim 99. Again, Type F is not the proper terminology but Class F is with respect to fly ash. It is also noted that it is new matter because applicants do not have any support for adding more than one kind of fly ash at a time in their claimed mixture. While they may be able to add different kinds of fly ash, they do not have support for adding different kinds of fly ash in the same mixture from the original disclosure.

It is noted that once again the amounts of components in claim 99 do not add up to 100 wt%. Applicants claim specific amounts of about 80 wt% Class C fly ash and about 10 wt% Portland cement which requires that the amount of catalyst (ie zeolite)

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remaining should be about 10 wt%. Without --about 10 wt%-- the amounts do not add up to 100 wt%. Again, not a suggestion but an observation of the problem with this claim.

There is no support for adding about 0.1 wt% to about 10 wt% "alkali containing feldspathoid and a combination thereof" as set forth in the newly added limitations of claim 99. This is new matter. There is only support for about 0.1 to about 10 wt% zeolite. No amounts or provided in the original disclosure for the amount of feldspathoid and combination thereof nor is there any hint of this range of amounts for other than zeolite.

Claim 108 is now rendered indefinite because applicants use the confusing combination of claim language of "comprising mixing materials consisting essentially of". On the one hand, other components can be added still to the composition by the use of comprising. Yet, the applicants contradict this language making it more closed using consisting essentially of". Applicants should choose one or the other but they cannot use both without it being vague.

The terms "80% or more" in claim 108 and other claims is both new matter and indefinite for the reasons provided above. The applicants are limited to either one data point of about 80 wt% or a range of amounts of about 80 wt% to about 95 wt% fly ash (pozzolanic material).

There is also no support for "one or more fly ash" mixed in a single mixture from the original disclosure and this is new matter in claim 108.

Claim 108 is also indefinite because the amounts of components do not add up to 100 wt%. Applicant state an amount of about 80 wt% fly ash but do not particularly point out and distinctly claim how much Portland cement and zeolite are also present in their claimed composition.

The terms "80% or more" is new matter in claim 115 for the same reasons as above. The terms "one or more fly ash" is also new matter.

Claim 115 is now rendered indefinite because applicants use the confusing combination of claim language of "comprising mixing materials consisting essentially of". On the one hand, other components can be added still to the composition by the use of comprising. Yet, the applicants contradict this language making it more closed using consisting essentially of". Applicants should choose one or the other but they cannot use both without it being vague

The "third quantity of one or more catalyst" is new matter in claim 115 because it implies catalysts other than those limited in the applicants instant invention including alkali containing zeolite, alkali containing feldspathoid, and combinations thereof. This omission of this limitation for the "third quantity" makes this claim new matter. It is also indefinite because applicants do not particularly point out and distinctly claim the identities of these specific catalysts.

New claims 123, 124, and 125 all contain new matter. The terms "about 80% or more" is new matter as is "one or more fly ash".

The amounts do not add up to 100 wt% either for all components.

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The terms "one or more compounds" before comprising ordinary Portland cement in claim 123 is also new matter and indefinite. There is no support for this nor do applicants distinctly claim what they are in this claim.

Claim 123 is also indefinite because applicants use both "consisting essentially of" and "comprising claim language which contradicts itself. The applicants use consisting essentially of in the preamble which limits their invention but further in the claim state "one or more compounds comprising". This is improper and indefinite.

Claim 124 teaches a new matter range of "about 2% or more by weight of catalyst" when applicants only have support for about 2 wt% to about 4 wt% catalyst (see original claim 17). Applicants do not have support for any amount greater than about 4 wt%. This is not a suggestion but a commentary on the state of this claim.

Claim 125 is indefinite for the same reason in that applicants are limited to a lower range of about 2 wt% and do not have support for any amounts under about 2 wt% and thus it is new matter. Again, this is not a suggestion but an observation of the issues involving this claim.

Response to Arguments:

Sobolev et al. '289 B2, Fu et al. '489 or '513, or *Niepelova et al.* (SK 279524) are the only art remaining yet the applicants arguments are directed to new matter limitations and thus these references would appear to still read upon the instant invention until that issue is further clarified. All teach the presence of Portland cement, zeolite, and fly ash and meet the limitations of the instant invention. It is believed that

applicants arguments are not convincing in view of the fact that the majority of their newly added limitations are new matter and/or indefinite.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Paul Marcantoni".

Paul Marcantoni
Primary Examiner
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